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10/651,841	08/29/2003	David Duncan	7535.00002	8173

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EXAMINER	
BARNES, CRYSTAL J	
ART UNIT	**PAPER NUMBER**
2121	

DATE MAILED: 03/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/651,841	DUNCAN ET AL.	
	Examiner	Art Unit	
	Crystal J. Barnes	2121	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 January 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *19 July 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. The following is a Non-Final Office Action in response to the Request for Continued Examination (RCE) received on 27 January 2006. Claims 1, 17 and 23 have been amended. Claim 27 has been added. Claims 1-27 are now pending in this application.

Specification

2. The disclosure is objected to because of the following informalities: related application numbers on page 1 [0001] should be entered. Appropriate correction is required.

Response to Arguments

3. Applicant's arguments, see Remarks page 8, filed 27 January 2006, with respect to the rejections of claims 1-26 under 35 USC 102(e) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground of rejection is made in view of Dearing et al. and Boman et al.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pub. No. 2002/0183882 A1 to Dearing et al. in view of US Pub. No. 2004/0100379 A1 to Boman et al.

As per claim 1, the Dearing et al. reference discloses a system for facilities management, including: a server (see page 3 [0040], "servers 26, 27"); a client ("client, controller") in communication with the server ("servers 26, 27"); a database ("profile database 30") in communication with the server ("servers 26, 27") and with the client ("client, controller"); and a personality module (see page 3 [0047], "reader 47") having associated processing power and memory, the personality module ("reader 47") comprising one or more ports for communicating with the server ("servers 26, 27"), with the client ("client, controller"), and with one or more field devices (see page 3 [0045], "MW 36").

The Dearing et al. reference does not expressly disclose a personality module having associated processing power and memory, the personality module comprising one or more ports.

The Boman et al. reference discloses

(see pages 3-4 [0048], "The container 10 is secured and tracked by a reader 16. Each reader 16 may include hardware or software for communicating with server 15 ... a cable for downloading data to a PC that transmits the data over the Internet to the server 15. The reader 16 may be ... a fixed reader 16(C). The reader serves primarily as a relay station between the device 12 and the server 15.")

(see page 4 [0049], "The server 15 stores a record of security transaction details ... The server 15 ... software backbone 17 ... may be accessible to authorized parties ...")

(see page 4 [0051], "The server 15 may communicate with the software backbone 17 ... support real-time surveillance services ... store information ... The software backbone 17 allows access ... via a user interface that may be accessed via ... the Internet")

(see page 7 [0086], "... the reader 16 includes ... a microprocessor 36, a memory 38, and a power supply 40.")

(see page 7 [0088], "... the memory 38 in the reader allow for control of data exchanges ... and also for a storage of such exchanged data. Necessary power for the operation of the components of the reader 16 is provided through power supply 40.")

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the reader taught by the Dearing et al. reference with the components of the reader taught by the Boman et al. reference to illustrate the components of a typical reader.

One of ordinary skill in the art would have been motivated to modify the reader with the components to provide a relay station between the container and the server in order to determine a last known location of the container, make integrity inquiries for any number of containers, or perform other administrative activities.

As per claim 2, the Dearing et al. reference discloses the client (see page 4 [0049], "client controller 45") includes a user interface ("GUI") designed to receive

customization information ("interaction") from a user ("users") that determines system operation ("system 25").

As per claim 3, the Dearing et al. reference discloses the client (see page 4 [0049], "client controller 45") includes a user interface ("GUI"), the user interface ("GUI") designed to receive customization information ("interaction") from a user ("users"), the customization information ("interaction") including portals (see page 3 [0045], "portals") and system configuration ("mechanisms to restrict access") information.

As per claim 4, the Dearing et al. reference discloses furthering including: an enclosure (see page 3 [0045], "MW 36"), wherein the personality module ("reader 47") is housed in the enclosure ("MW 36").

As per claim 5, the Dearing et al. reference discloses further including: an enclosure ("MW 36"); a plurality of personality modules ("reader 47"); wherein the plurality of personality modules ("reader 47") are housed in the enclosure ("MW 36").

As per claim 6, the Dearing et al. reference discloses the personality module ("reader 47") is modular and is selected from a plurality of personality module types (see page 5 [0056], "smartcard, a magnetic card swipe device, a barcode

device, a fingerprint reader"), each type ("smartcard, a magnetic card swipe device, a barcode device, a fingerprint reader") having a distinct set of characteristics defining personality module functionality ("reader 47").

As per claim 7, the Dearing et al. reference discloses the plurality of personality module types ("smartcard, a magnetic card swipe device, a barcode device, a fingerprint reader") includes a reader module ("reader 47") and I/O module ("barcode device").

As per claim 8, the Dearing et al. reference discloses upon installation the personality module ("reader 47") automatically receives an IP address (see page 3 [0040], "TCP/IP").

As per claim 9, the Dearing et al. reference discloses the personality module ("reader 47") includes an operating system (see Boman et al. page 3 [0048], "hardware or software").

As per claim 10, the Dearing et al. reference discloses the personality module ("reader 47") includes a software application (see Boman et al. page 3 [0048], "hardware or software") designed to communicate directly with a third-party system (see page 3 [0044], "manufacturing infrastructure and marketing, customer relation management, billing, other systems").

As per claim 11, the Dearing et al. reference discloses a plurality of enclosures (see page 3 [0045], "MW 36"), wherein each enclosure ("MW 36") is capable of housing a plurality of personality modules ("see page 3 [0045], "products", and [0047], "reader 47"); wherein personality modules ("products, reader 47") can be dynamically removed from or added to (see page 5 [0056], "missing or added") an enclosure ("MW 36") while the system is in operation; wherein enclosures ("MW 36") can be dynamically removed from (see page 5 [0058], "lock down") or added to the system while the system is in operation.

As per claim 12, the Dearing et al. reference discloses the personality module ("reader 47") operates autonomously (see page 3 [0041], "administration of badges or keys") from the server ("servers 26, 27").

As per claim 13, the Dearing et al. reference discloses the personality module ("reader 47" and see page 6 [0060], "ERP system 124, web ordering system 126, passkey administration system 128, MW administration system 130") stores all information required to autonomously perform facilities management functions ("assign RF tags 95 to selected products or lots of products; assign identities to each MW 36; handle inventory planning; handle re-supplying of MWs; handle sales

orders, process customer order inquiries; inventory inquiries; passkey updates; and purchase order updates").

As per claim 14, the Dearing et al. reference discloses further including: an enclosure (see page 3 [0047], "MW 36"), wherein the personality module ("reader 47, optional input devices") is housed in the enclosure ("MW 36"); and a display module ("reader 47, optional input devices" and see page 3 [0046], "display screen") is housed in the enclosure ("MW 36").

As per claim 15, the Dearing et al. reference discloses the display module ("reader 47, optional input devices") includes an LCD touchscreen (see page 5 [0056], "fingerprint reader").

As per claim 16, the Dearing et al. reference discloses the display module ("display screen") includes a user interface (see page 4 [0049], "GUI") to be displayed on a display screen ("display screen"), the user interface ("GUI") designed to interact ("interaction") with the personality module ("reader 47, optional input devices").

As per claim 17, the Dearing et al. reference discloses a system for facilities management, including: a server (see page 3 [0040], "servers 26, 27"); a client

("client, controller") in communication with the server ("servers 26, 27"); a database ("profile database 30") in communication with the server ("servers 26, 27") and with the client ("client, controller"); and an enclosure (see page 3 [0045], "MW 36") in communication with the server ("servers 26, 27"), with the client ("client, controller"), and with a field device (see page 3 [0045], "MW 36") wherein the enclosure ("MW 36") is capable of housing at least one modular personality module (see page 3 [0047], "reader 47") selected from a plurality of personality module types ("reader 47"), each type having an associated processing power and memory and a distinct set of characteristics defining personality module functionality ("MW enterprise application 29, products, reader 47").

The Dearing et al. reference does not expressly disclose each type having an associated processing power and memory.

The Boman et al. reference discloses

(see pages 3-4 [0048], "The container 10 is secured and tracked by a reader 16. Each reader 16 may include hardware or software for communicating with server 15 ... a cable for downloading data to a PC that transmits the data over the Internet to the server 15. The reader 16 may be ... a handheld reader 16(A), a

mobile reader 16(B), or a fixed reader 16(C). The reader serves primarily as a relay station between the device 12 and the server 15.")

(see page 7 [0086], "... the reader 16 includes ... a microprocessor 36, a memory 38, and a power supply 40.")

(see page 7 [0088], "... the memory 38 in the reader allow for control of data exchanges ... and also for a storage of such exchanged data. Necessary power for the operation of the components of the reader 16 is provided through power supply 40.")

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the reader taught by the Dearing et al. reference with the components of the variety of readers taught by the Boman et al. reference to illustrate the components of a typical reader.

One of ordinary skill in the art would have been motivated to modify the reader with the components to provide a relay station between the container and the server in order to determine a last known location of the container, make integrity inquiries for any number of containers, or perform other administrative activities.

As per claim 18, the Dearing et al. reference discloses the plurality of personality module types (see page 5 [0056], "smartcard, a magnetic card swipe device, a barcode device, a fingerprint reader") includes a reader module ("reader 47") and I/O module ("barcode device, a fingerprint reader").

As per claim 19, the Dearing et al. reference discloses upon installation the personality module ("reader 47") automatically receives an IP address (see page 3 [0040], "TCP/IP").

As per claim 20, the Dearing et al. reference discloses a plurality of enclosures (see page 3 [0045], "MW 36"), wherein each enclosure ("MW 36") is capable of housing a plurality of personality modules ("see page 3 [0047], "reader 47"); wherein personality modules ("reader 47") can be dynamically removed from or added to (see page 5 [0056], "missing or added") an enclosure ("MW 36") while the system is in operation; wherein enclosures ("MW 36") can be dynamically removed from (see page 5 [0058], "lock down") or added to the system while the system is in operation.

As per claim 21, the Dearing et al. reference discloses the personality module ("reader 47 and MW enterprise application 29") operates autonomously (see

page 3 [0041], "administration of badges or keys") from the server ("servers 26, 27").

As per claim 22, the Dearing et al. reference discloses further including: a display module (see page 3 [0046], "display screen") housed in the enclosure ("MW 36"), the display module ("display screen") includes a user interface (see page 4 [0049], "GUI") to be displayed on a display screen ("display screen"), the user interface ("GUI") designed to interact ("interaction") with the personality module ("reader 47, optional input devices").

As per claim 23, the Dearing et al. reference discloses an apparatus for use in a facilities management system that includes a server, the apparatus comprising: an enclosure (see page 3 [0045], "MW 36"); a plurality of personality modules (see page 5 [0056], "smartcard, a magnetic card swipe device, a barcode device, a fingerprint reader") housed in the enclosure ("MW 36"); wherein the personality modules ("reader 47") are modular; and wherein each personality module ("reader 47") is selected from a plurality of personality modules types ("smartcard, a magnetic card swipe device, a barcode device, a fingerprint reader"), each type having an associated processing power and memory and a distinct set of

characteristics ("smartcard, a magnetic card swipe device, a barcode device, a fingerprint reader") defining personality module functionality ("reader 47"); and wherein each personality module ("reader 47") is independently addressable (see page 3 [0040], "TCP/IP" and page 4 [0052], "identification tag 95").

The Dearing et al. reference does not expressly disclose each type having an associated processing power and memory.

The Boman et al. reference discloses

(see pages 3-4 [0048], "The container 10 is secured and tracked by a reader 16. Each reader 16 may include hardware or software for communicating with server 15 ... a cable for downloading data to a PC that transmits the data over the Internet to the server 15. The reader 16 may be ... a handheld reader 16(A), a mobile reader 16(B), or a fixed reader 16(C). The reader serves primarily as a relay station between the device 12 and the server 15.")

(see page 7 [0086], "... the reader 16 includes ... a microprocessor 36, a memory 38, and a power supply 40.")

(see page 7 [0088], "... the memory 38 in the reader allow for control of data exchanges ... and also for a storage of such exchanged data. Necessary power for

the operation of the components of the reader 16 is provided through power supply 40.")

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the reader taught by the Dearing et al. reference with the components of the variety of readers taught by the Boman et al. reference to illustrate the components of a typical reader.

One of ordinary skill in the art would have been motivated to modify the reader with the components to provide a relay station between the container and the server in order to determine a last known location of the container, make integrity inquiries for any number of containers, or perform other administrative activities.

As per claim 24, the Dearing et al. reference discloses each personality module ("reader 47") is dynamically swappable with another type of personality module (see page 5 [0055], "smartcard, magnetic card swipe device, barcode device, fingerprint reader" and page 7 [0069], "biometric device 404, reader 408").

As per claim 25, the Dearing et al. reference discloses the Dearing et al. reference discloses the personality module ("reader 47 and MW enterprise

application 29") operates autonomously (see page 3 [0041], "administration of badges or keys") from a server ("servers 26, 27").

As per claim 26, the Dearing et al. reference discloses the enclosure ("MW 36") further houses a display module (see page 3 [0046], "display screen"), wherein a user interface (see page 4 [0049], "GUI") is to be displayed with the display module ("display screen"), the user interface ("GUI") for interacting ("interaction") with the personality modules ("products, reader 47, optional input devices") housed in the enclosure ("MW 36").

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claim 27 is rejected under 35 U.S.C. 102(e) as being anticipated by US Pub. No. 2004/0100379 A1 to Boman et al.

As per claim 27, the Boman et al. reference discloses a system for facilities management, including: a server (see page 3 [0048], "server 15"); a client ("software backbone 17") in communication with the server ("server 15"); a database (see page 4 [0049], "server 15") in communication with the server ("server 15") and with the client ("software backbone 17"); and a personality module (see page 4 [0048], "reader 16") having an operating system (see page 3 [0048], "hardware or software"), the personality module ("reader 16") in communication with the server ("server 15"), with the client ("software backbone 17"), and with a field device (see page 3 [0048], "container 10").

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*,

759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1, 17, 21, 25 and 27 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 5, 6, 12 and 13 of copending Application No. 10/651,846. Although the conflicting claims are not identical, they are not patentably distinct from each other because application claims 1, 17, 21, 25 and 27 define an obvious variation of the invention claimed in copending Application No. 10/651,846. Claims 5, 6, 12 and 13 of copending Application No. 10/651,846 contain every element of claims 1, 17, 21, 25 and 27 of the instant application and as such anticipated claims 1, 17, 21, 25 and 27 of the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following references are cited to further show the state of the art with respect to readers and I/O devices in general:

USPN 5,659,761 to De Arras et al.

USPN 5,252,967 to Brennan et al.

US Pub. No. 2005/0040224 A1 to Brinton et al.

US Pub. No. 2004/0056085 A1 to Adams

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Crystal J. Barnes whose telephone number is 571.272.3679. The examiner can normally be reached on Monday-Friday alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Knight can be reached on 571.272.3687. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Crystal J. Barnes

CJB

23 February 2006